

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED
CENTRAL FAX CENTER**

In re Application of:

Scott Watson, et al.

Application No.: 10/646,192

Conf. No.: 9068

Filed: August 21, 2003

For: DIGITAL HOME MOVIE LIBRARY

Technology Center 2600

Examiner: Huynh, Son P.
Art Unit: 2623**JAN 22 2007****APPEAL BRIEF**

MAIL STOP – APPEAL BRIEF – PATENTS
COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal brief is submitted in connection with the Notice of Appeal submitted on October 20, 2006 regarding the above-identified patent application.

REAL PARTY-IN-INTEREST

The real party-in-interest is Disney Enterprises, Inc., assignee of the above-identified patent application.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences that are related to the present appeal.

01/24/2007 AWONDAF1 00000158 503130 10646192

01 FC:1402 500.00 DA

1

STATUS OF CLAIMS

Claims 4-16, 18-35, 37, 41-48, 52-59, 61, 63, 72-100 are currently pending. Claims 60, 62, 64-68, were previously withdrawn in response to a restriction requirement.

STATUS OF AMENDMENTS

Amendments to claims 9-11, 15, 18-19, 23, 26-27, 30, 41-47, 52, 54, 58-59, 61, 76-78, 80-82, and 88 were previously submitted, but not entered by the Examiner. Accordingly, the attached index of claims reflects the pending claims and does not reflect the claim amendments that the Examiner, in an Advisory Action, dated November 2, 2006, refused to enter.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 4 is directed towards “A method of broadcasting a movie to a set-top box, the method comprising: a content provider broadcasting movie data to a set-top box, the content of the movie data being selected by the content provider; permitting automatic storage of the movie data broadcast from the content provider onto the set-top box; permitting assembling the movie data in the set top box to form at least one full movie and associated metadata; permitting analysis of the metadata to determine when to make the movie available for viewing; and permitting viewing of the movie in response to a user’s selection of the movie,” see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 10 is directed to “A method of broadcasting movies to a set-top box, the method comprising: a content provider broadcasting movie data to a set-top box, the content of the movie data being selected by the content provider and not by the user; permitting automatic storage on the set-top

box of the movie data broadcast from the content provider; permitting assembly of the movie data to form a plurality of full movies; making selected movies available for viewing by the user at a time pre-determined by the content provider, the selected movie having previously been stored on the set-top box; and effecting removal of the movie data representing one or more movies stored on the set-top box at a time determined by the content provider," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 18 is directed to "A method of broadcasting movies to a set-top box for storage and subsequent viewing, the method comprising: selectively broadcasting data wirelessly from a content provider to a set-top box; remotely controlling when to make data available for viewing by the user; and remotely controlling when to remove data from the set-top box," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 23 is directed to "A method of content management for a remote hardware device, the method comprising the steps of: collecting content to be transmitted to a remote hardware device; generating metadata specifying various properties of the content; associating the metadata with the content; transmitting the content and its associated metadata to the remote hardware device; permitting automatic storage of the data received at the remote hardware device; providing software for operating on the remote hardware device to process the metadata and manage the content according to its associated metadata," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16,

paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 26 is directed to "A method of providing movies available for purchase or rental directly to remote viewers through broadcast communication, the method comprising; providing a viewer with a set top box, the set top box having a hard drive for storing a plurality of movies; broadcasting movie data to the set top box and allowing movie data to accumulate on the hard drive; and providing software resident on the set top box, the software being programmed to: automatically store the movie data broadcast to the set top box; assemble the movie data into a plurality of viewable movies and associated metadata; analyze the metadata to determine when a movie should be made available; and allow the user to select the available movie when available," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 30 is directed towards "A method of creating a digital home movie library, the method comprising the steps of: having a content provider broadcast movie data to a plurality of set-top boxes, the content of the movie data being selected by the content provider and being uncontrolled by the user; automatically storing on the set-top box the movie data broadcast from the content provider; assembling the movie data to form a plurality of full movies; and making one or more of the movies available to the user at a time predetermined by the content provider," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Attorney Docket: 038.P010

Claim 37 is directed towards "A method of distributing movies directly to viewers at home comprising: providing a viewer with a set top box, the set top box having a hard drive for storing a plurality of movies and software for permitting access to the movies; broadcasting at least one movie and associated data to the set top box wirelessly prior to an official release date for the movie, the associated data regulating the release date of the movie on the set top box; and automatically storing the movies and its associated data to the set top box hard drive; analyzing the associated data to determine when the movies should be made available for viewing; and permitting viewing of the movie on its release date," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 41 is directed towards "A digital home movie library system for providing access to the movies comprises: an antenna and a tuner for receiving broadcast signals; a hard disk drive for storing movie data and metadata transmitted by the broadcast signals and received through the antenna; and a processor for executing software, processing data received through the antenna and tuner, and for processing user input commands to permit access to the stored movie data under predetermined control conditions derived from the metadata," see specification page 10, paragraph [0047] to page 11, paragraph [0056]; page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 43 is directed towards "A system for providing access to movies comprising: an antenna and receiver for receiving broadcast signals; a processor for executing software, processing data received through the antenna and tuner, and for processing user input commands to permit access to the stored movie data under predetermined control conditions; a hard disk drive for storing movie data transmitted

Attorney Docket: 038.P010

by the broadcast signals and received through the antenna; and a smart card secured to a circuit board of the receiver, the smart card facilitating a dedicated use of the receiver with a designated user," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218]; and/or Figs. 1, 1a, and 1e, for example.

Claim 52 is directed towards "A method of a remote user receiving a movie broadcast to a set-top box, the method comprising: receiving movie data broadcast by a content provider to a set-top box of a user, the content of the movie data being selected by the content provider; storing of the movie data broadcast from the content provider onto the set-top box; assembling the movie data in the set top box to form at least one full movie and associated metadata; analyzing of the metadata to determine when to make the movie available for viewing; and viewing of the movie in response to the remote user's selection of the movie," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 56 is directed towards "A method of a remote user receiving a broadcast movie to a set-top box, the method comprising: receiving from a content provider movie data broadcast to a set-top box, the content of the movie data being selected by the content provider and not by the remote user; automatically storing on the set-top box the movie data broadcast from the content provider; assembling of the movie data to form a plurality of full movies; selecting movies for viewing by the user at a time pre-determined by the content provider, the selected movie having previously been stored on the set top box; and removing the movie data representing one or more movies stored on the set top box at a time determined by the content provider," see specification page 10, paragraph [0047] to page 11, paragraph

[0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 59 is directed towards "A method of receiving a broadcast a movie on a set-top box of a remote user, the method comprising: receiving a broadcast movie from a content provider broadcasting movie data to a set-top box, the content of the movie data being selected by the content provider; and storing for a predetermined time on the set top box the movie data broadcast from the content provider onto the set-top box, the predetermined time being established by the content provider," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 72 is directed towards "A method of broadcasting a video to a set-top box, the method comprising: a content provider broadcasting video data to a set-top box, the content of the video data being selected by the content provider; permitting automatic storage of the video data broadcast from the content provider onto the set-top box; permitting assembling the video data in the set top box to form at least one full video and associated metadata; permitting analysis of the metadata to determine when to make the video available for viewing; and permitting viewing of the video in response to a user's selection of the video," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 83 is directed towards "A method of remotely deleting content on a set top box, comprising: transmitting metadata from a content provider to a set top box, the metadata being

Attorney Docket: 038.P010

associated with content previously stored on the set top box, the metadata being utilized by the set top box to delete the content," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 88 is directed towards "A method of remotely deleting content from a set top box, comprising: composing an instruction to delete specific content previously stored on a set top box; and transmitting metadata including the instruction to delete specific content to the set top box, the set top box having logic therein that interprets the instruction and deletes the previously stored content referenced in the instruction," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 91 is directed towards "A method of remotely managing content on a set top box, comprising: transmitting metadata to a set top box, the metadata being associated with content previously stored on the set top box, the metadata being utilized by the set top box to make the content unavailable to a user," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 95 is directed towards "A method of displaying available movies stored on a set top box, comprising: receiving a plurality of movies from a content provider; receiving a plurality of sets of metadata, each of the sets of metadata being associated with one of the plurality of movies; and analyzing each of the sets of metadata to determine if the set of metadata meets pre-determined criteria

Attorney Docket: 038.P010

established by the content provider for displaying the movie associated with the set of metadata in a listing of available movies for viewing in a user interface associated with the set top box," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

Claim 98 is directed towards "A method of displaying available movies stored on a set top box, comprising: establishing pre-determined criteria that determine whether content should be displayed; composing metadata that includes the pre-determined criteria; transmitting content associated with the metadata to the set top box; and transmitting the metadata to the set top box so that the metadata is analyzed to determine if the pre-determined criteria is met, the content being made available for viewing if the pre-determined criteria is met," see specification page 10, paragraph [0047] to page 11, paragraph [0056], page 16, paragraph [0087], page 27, paragraph [0182] to page 28, paragraph [0187], page 31, paragraph [0198] to page 33, paragraph [0218], and/or Figs. 1, 1a, and 1e, for example.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 4-10, 12-16, 18-35, 37, 41-42, 52-59, 61, 63, 72-77, and 79-100 stand rejected under 35 USC § 102(e) as being anticipated by US patent publication no. 2002/0056118 by Hunter, et al. (hereinafter, "Hunter"). Claim 11 stands rejected under 35 USC § 103(a) as being unpatentable over Hunter. Claim 78 stands rejected under 35 USC § 103(a) as being unpatentable over Hunter in view of Dodson et al., U.S. Patent No. 6,184,877 (hereinafter, "Dodson"). Claims 43-48 stand rejected under 35 USC § 103(a) as being unpatentable over Hunter in view of Maruo, U.S. Patent No. 6,757,909 (hereinafter, "Maruo").

ARGUMENT**1. THE EXAMINER INCORRECTLY RELIES UPON INHERENCY AS THE PRIMARY BASIS FOR HIS CLAIM REJECTIONS UNDER 35 USC § 102.**

As is well-established, for an Examiner to successfully or properly make a *prima facie* rejection under 35 USC § 102, the Examiner must provide a prior art document that includes each and every element and limitation of the rejected claim or claims. If even a single limitation is not present in the applied document, then the Examiner has failed to make a proper rejection under 35 USC § 102. Here, while the Examiner asserts that nearly all of the pending claims are anticipated by Hunter, the crux of his rejection of these claims relies upon the position that the claim elements and limitations are present in Hunter *inherently*, rather than expressly. In this aspect of the Examiner's position, Assignee asserts that the Examiner is incorrect.

Unfortunately and inadvertently, the Examiner, having first read Assignee's specification before coming upon Hunter, could, through a misinterpretation or a misunderstanding of Hunter, come to believe that Hunter discloses or teaches subject matter invented by Assignee; however, a rigorous application of the appropriate legal standard demonstrates, instead, that the Examiner has inappropriately and incorrectly divined Assignee's claimed subject matter from Hunter when, in reality, that subject matter is not disclosed by Hunter, either expressly or *inherently*. This situation is a classic case of the application of hindsight to incorrectly conclude that claimed subject matter deserving of protection is unpatentable. Thus, Assignee respectfully disagrees with the Examiner's contention regarding the inherent teaching of Hunter and Assignee believes that the Examiner has not established a *prima facie* case of anticipation as a result of this error.

As is well-settled law, to establish inherency, "extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that *it would be so recognized* by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis supplied). *See also* MPEP § 2163.07(a). In the present case, the Examiner has not established any basis for his stated position regarding inherency. Specifically, the Examiner has not established that the missing descriptive matter is *necessarily* present in Hunter. Likewise, the Examiner has also not established that the missing descriptive matter *would be recognized* by one of ordinary skill. Most recently, the Federal Circuit has stated that to establish inherent anticipation, it *must* be shown that "the disclosure [of the cited document] is sufficient to show that the natural result flowing from the operation as taught [in the cited document] would result in the claimed [subject matter]." SmithKline Beecham Corp. v. Apotex Corp., 403 F3d 1331, 1343 (Fed. Cir. 2005). The Examiner has failed to show that the natural result flowing from the operation disclosed in Hunter would provide Assignee's claimed subject matter. Perhaps more importantly, it is *not* the case that the natural result flowing from the operation disclosed in Hunter *would* provide Assignee's claimed subject matter. Accordingly, Assignee respectfully traverses these rejections as improperly made.

At a high-level, the Examiner makes several major contentions regarding the subject matter disclosed by Hunter which are not correct. One contention made by the Examiner, in his exact words, is that "metadata comprises information such as time stamp which determine begin and end date of movie must be included so that the certain movie is remained in storage for a period of time, say one week, regardless of the traffic through storage." Office Action, dated April 21, 2006, page 5. Another contention made by the Examiner is that "metadata is *inherently* analyzed to determine when to make the

Attorney Docket: 038.P010

movie available for viewing ... regardless of 'traffic' through storage module." Office Action, dated, April 21, 2006, page 3. (emphasis supplied) However, contrary to the Examiner's statements, Hunter only describes a first-in, first-out storage protocol. Thus, it does not teach, for example, how to determine when to remove a movie from storage or how to maintain a certain movie in storage regardless of the traffic through storage. Thus, the Examiner has failed to clearly show "that the missing descriptive matter is *necessarily* present in [Hunter], and that it *would be so recognized* by persons of ordinary skill," as required by MPEP § 2163.07(a) and the Court of Appeals for the Federal Circuit (emphasis added). Rather, Hunter does not disclose or teach, either expressly or *inherently*, the subject matter of Assignee's claims rejected under § 102. The specific language of each claim, of course, is discussed below. However, what is missing from Hunter, as will become clear as each claim is discussed, is any express or inherent disclosure regarding various elements and limitations of the claims that have been rejected as anticipated. Therefore, it is respectfully requested that the Examiner's rejections on this basis be reversed by the Board.

Furthermore, Hunter is almost precisely the opposite of what the Examiner says that it is. According to the Examiner, Hunter "determine[s] when to make the movie available" and "movies are available with a particular period... regardless of 'traffic' through storage module." Office Action, dated, April 21, 2006, page 3. According to the Examiner, based on Hunter, "the movie data representing one or more movies stored on the set top box is *inherently* effecting removed at a time determined by the content provider (i.e., only be remove/overwritten after one week, as determined by the content provider regardless of the 'traffic' through storage module)." Office Action, dated, April 21, 2006, page 4.

Hunter, however, does just the opposite. Specifically, Hunter discloses a "first in, first out" write-over protocol would permit each automatically downloaded movie to remain in storage module .

Attorney Docket: 038.P010

230 and available for on-demand viewing for approximately two weeks, with the exact time depending on how many customer-selected movies are downloaded during that period." See Hunter, paragraph 0139 (emphasis supplied). Hunter goes on to explain that "[t]he objective is for the storage module 230 to have available for on-demand viewing a large percentage of movies that any particular customer may be interested in at any given time – or at least have those movies available to the customer over a period of time as new entries into storage overwrite older entries." See Hunter, paragraph 0141 (emphasis supplied).

Thus, Hunter teaches away from using metadata to determine when to remove a movie from storage. In this regard, Hunter states "[h]owever the expression of movies preferences is made, this information may be used alone, or in conjunction with other information, to permit the customer's user station to download to memory (e.g., fifteen movie capacity) an ongoing, rolling selection of movies that will most likely match the preferences of the customer." See Hunter, paragraph 0142 (emphasis supplied). It is noted that Hunter does states "[w]hile a first-in, first-out protocol may be used for overwriting onto the hard drive of module 230, the catalogue information may serve to establish a different protocol that will *overwrite* the less likely to be purchased movies ahead of those recordings which, by analysis at module 340, show more promise for being viewed by the customer." See Hunter, paragraph 0144. (emphasis supplied) Thus, Hunter does not, as the Examiner asserts, teach a system in which analysis of metadata associated with a movie is used *to determine when* movies are made available for viewing.

A. WITH REGARD TO CLAIM 4 (AND ITS DEPENDENT CLAIMS OTHER THAN 9), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE

"PERMITTING ANALYSIS OF THE METADATA TO DETERMINE WHEN TO MAKE THE MOVIE AVAILABLE FOR VIEWING."

With respect to the merits of the Examiner's rejection, we begin with claim 4. Specifically, Hunter does not teach "permitting analysis of the metadata to determine when to make the movie available for viewing," as recited in Assignee's claim 4. The Examiner readily admits that at least this portion of Assignee's claim 4 is not explicitly taught by Hunter. Instead, the Examiner asserts that this aspect of Assignee's claim 4 is *inherently* taught by Hunter. However, the Examiner does not provide any basis for this assertion. Hunter only discloses a system wherein "[t]he user station downloads movies to the intermediate storage in storage module 230 just as if the recording had been preselected by the customer. The graphical user interface alerts the customer that the recordings are available by a cue such as 'YOU'VE GOT FLICKS'." See Hunter, paragraph 0139. Nowhere in Hunter is it disclosed or described "permitting the analysis of the metadata to determine when to make the movie available for viewing," as recited in Assignee's claim 4. For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 4 is improper and respectfully requests that the Board reverse the Examiner's claim rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to those claims that depend from claim 4, other than claim 9, as well.

B. WITH REGARD TO CLAIM 9, HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "REPEATEDLY RE-BROADCASTING MOVIE DATA THEREBY TO ENSURE THAT THE ENTIRE MOVIE IS RECEIVED BY THE SET-TOP BOX."

With regard to claim 9, Hunter does not teach, *inherently* or otherwise, "repeatedly re-broadcasting movie data thereby to ensure that the entire movie is received by the set-top box," as recited by Assignee's claim 9. In rejecting this claim, the Examiner states that Hunter teaches that

Attorney Docket: 038.P010

"movies are broadcast every 30 minutes from 5:30 pm to 8:30 pm, and several other times daily." While Assignee does not concede that the Examiner's characterization of Hunter is correct in this regard, it is clear from the Examiner's own understanding of Hunter that Hunter does not teach each and every element of Assignee's claim 9. Specifically, Hunter makes no mention of "repeatedly re-broadcasting movie data to ensure that the entire movie is received by the set-top box," as recited by Assignee's claim 9. Hunter makes no mention of "re-broadcasting movie data." For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 9 is improper and respectfully requests that the Board reverse the Examiner's claim rejection.

C. WITH REGARD TO CLAIM 10 (AND ITS DEPENDENT CLAIMS OTHER THAN 11 AND 15), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "EFFECTING REMOVAL OF THE MOVIE DATA REPRESENTING ONE OR MORE MOVIES STORED ON THE SET-TOP BOX AT A TIME DETERMINED BY THE CONTENT PROVIDER."

With regard to claim 10, Assignee respectfully asserts that Hunter does not teach, *inherently* or otherwise, "effecting removal of the movie data representing one or more movies stored on the set-top box at a time determined by the content provider," as recited by Assignee's claim 10. In rejecting this claim, the Examiner asserts that "the content provider controls the downloading of movies into the set top box ... Thus, the movie data representing one or more movie stored on the set top box is effectively removed at the time determined by the content provider (e.g. when the new movie is downloaded or when the period of time designated for certain new release movies to remain is expired)." However, Assignee respectfully asserts that the Examiner has misconstrued or misunderstood Hunter. Specifically, in Hunter, the content provider does not control the downloading of movies and, therefore, cannot *necessarily* determine a time for removal of movie data. For example, Hunter states that its system uses

Attorney Docket: 038.P010

a "first in, first out" write-over protocol that "would permit each automatically downloaded movie to remain in storage module 230 and available for on-demand viewing for approximately two weeks, with the exact time depending on how many customer-selected movies are downloaded during that period." See Hunter, paragraph 0139 (emphasis supplied). As discussed above, the Examiner has failed to clearly show "that the missing descriptive matter is *necessarily* present in [Hunter], and that it *would be so recognized* by persons of ordinary skill," because Hunter does not teach "effecting removal of the movie data representing one or more movies stored on the set-top box at a time determined by the content provider," as recited in Assignee's claim 10. Therefore, Assignee respectfully asserts that the Examiner's rejection of claim 10 is improper and respectfully requests that the Board reverse the Examiner's claim rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to those claims that depend from claim 10, other than claims 11 and 15, as well.

D. WITH REGARD TO CLAIM 15, HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "REPEATEDLY RE-BROADCASTING MOVIE DATA THEREBY TO ENSURE THAT THE ENTIRE MOVIE IS RECEIVED BY THE SET-TOP BOX."

With regard to claim 15, Hunter does not teach, *inherently* or otherwise, "repeatedly re-broadcasting movie data thereby to ensure that the entire movie is received by the set-top box," as recited by Assignee's claim 15. In rejecting this claim, the Examiner states that Hunter teaches that "movies are broadcast every 30 minutes from 5:30 pm to 8:30 pm, and several other times daily." While Assignee does not concede that the Examiner's characterization of Hunter is correct in this regard, it is clear from the Examiner's own understanding of Hunter that Hunter does not teach each and every element of Assignee's claim 15. Specifically, Hunter makes no mention of "repeatedly re-broadcasting movie data thereby to ensure that the entire movie is received by the set-top box," as recited by

Attorney Docket: 038.P010

Assignee's claim 15. Hunter makes no mention of "re-broadcasting movie data." For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 15 is improper and respectfully requests that the Board reverse the Examiner's claim rejection.

E. WITH REGARD TO CLAIM 18 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "REMOTELY CONTROLLING WHEN TO MAKE DATA AVAILABLE FOR VIEWING BY THE USER; AND REMOTELY CONTROLLING WHEN TO REMOVE DATA FROM THE SET-TOP BOX."

With regard to claim 18, Assignee respectfully asserts that Hunter does not teach, *inherently* or otherwise, "remotely controlling when to make data available for viewing by the user; and remotely controlling when to remove data from the set-top box," as recited by Assignee's claim 18. Assignee respectfully asserts that the Examiner has misconstrued or misunderstood Hunter. Specifically, in Hunter, the content provider does not control the downloading of movies and, therefore, cannot necessarily determine a time for removal of movie data. For example, Hunter states that its system uses a "first in, first out" write-over protocol that "would permit each automatically downloaded movie to remain in storage module 230 and available for on-demand viewing for approximately two weeks, with the exact time depending on how many customer-selected movies are downloaded during that period." See Hunter, paragraph 0139 (emphasis supplied). As discussed above, the Examiner has failed to clearly show "that the missing descriptive matter is *necessarily* present in [Hunter], and that it *would be so recognized* by persons of ordinary skill," because Hunter does not teach "remotely controlling when to make data available for viewing by the user; and remotely controlling when to remove data from the set-top box," as recited by Assignee's claim 18. For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 18 is improper and respectfully requests that the Board reverse the

Attorney Docket: 038.P010

Examiner's claim rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to those claims that depend from claim 18, as well.

F. WITH REGARD TO CLAIM 23 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "PROVIDING SOFTWARE FOR OPERATING ON THE REMOTE HARDWARE DEVICE TO PROCESS METADATA AND MANAGE THE CONTENT ACCORDING TO ITS ASSOCIATED METADATA."

With regard to claim 23, Assignee respectfully asserts that Hunter does not teach, *inherently* or otherwise, "providing software for operating on the remote hardware device to process the metadata and manage the content according to its associated metadata," as recited by Assignee's claim 23. Assignee respectfully asserts that the Examiner has misconstrued or misunderstood Hunter. Specifically, in Hunter the content provider does not teach a system that manages "content according to its associated metadata." For example, Hunter states that its system uses a "first in, first out" write-over protocol that "would permit each automatically downloaded movie to remain in storage module 230 and available for on-demand viewing for approximately two weeks, with the exact time depending on how many customer-selected movies are downloaded during that period." See Hunter, paragraph 0139 (emphasis supplied). As discussed above, the Examiner has failed to clearly show "that the missing descriptive matter is *necessarily* present in [Hunter], and that it *would be so recognized* by persons of ordinary skill," because Hunter does not teach "providing software for operating on the remote hardware device to process the metadata and manage the content according to its associated metadata," as recited by Assignee's claim 23. For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 23 is improper and respectfully requests that the Board reverse the Examiner's claim

rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to those claims that depend from claim 23, as well.

G. WITH REGARD TO CLAIM 26 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "PROVIDING SOFTWARE...TO ANALYZE THE METADATA TO DETERMINE WHEN A MOVIE SHOULD BE MADE AVAILABLE."

With regard to claim 26, Hunter does not teach, *inherently* or otherwise, "providing software ... to analyze the metadata to determine when a movie should be made available," as recited by Assignee's claim 26. Hunter only discloses a system wherein "[t]he user station downloads movies to the intermediate storage in storage module 230 just as if the recording had been preselected by the customer. The graphical user interface alerts the customer that the recordings are available by a cue such as "YOU'VE GOT FLICKS'." See Hunter, paragraph 0139. Nowhere in Hunter does it disclose or describe "providing software ... to analyze the metadata to determine when a movie should be made available," as recited in Assignee's claim 26. For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 26 is improper and respectfully requests that the Board reverse the Examiner's claim rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to those claims that depend from claim 26, as well.

H. WITH REGARD TO CLAIM 30 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "MAKING ONE OR MORE OF THE MOVIES AVAILABLE TO THE USER AT A TIME PREDETERMINED BY THE CONTENT PROVIDER."

Attorney Docket: 038.P010

With regard to claim 30, Hunter does not teach, *inherently* or otherwise, "making one or more of the movies available to the user at a time predetermined by the content provider," as recited by Assignee's claim 30. In rejecting similar claim language, the Examiner states that Hunter teaches that "movies are broadcast every 30 minutes from 5:30 pm to 8:30 pm, and several other times daily." While Assignee does not concede that the Examiner's characterization of Hunter is correct in this regard, it is clear from the Examiner's own understanding of Hunter that Hunter does not teach each and every element of Assignee's claim 30. Rather, Hunter only discloses a system wherein "[t]he user station downloads movies to the intermediate storage in storage module 230 just as if the recording had been preselected by the customer. The graphical user interface alerts the customer that the recordings are available by a cue such as 'YOU'VE GOT FLICKS'." See Hunter, paragraph 0139. Nowhere in Hunter does it teach "providing software ... to analyze the metadata to determine when a movie should be made available," as recited in Assignee's claim 30. For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 30 is improper and respectfully requests that the Board reverse the Examiner's claim rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to those claims that depend from claim 30, as well.

I. WITH REGARD TO CLAIM 37 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "ANALYZING THE ASSOCIATED DATA TO DETERMINE WHEN THE MOVIES SHOULD BE MADE AVAILABLE FOR VIEWING."

With regard to claim 37, Hunter does not teach, *inherently* or otherwise, "analyzing the associated data to determine when the movies should be made available for viewing," as recited by Assignee's claim 37. Hunter only discloses a system wherein "[t]he user station downloads movies to the intermediate storage in storage module 230 just as if the recording had been preselected by the

Attorney Docket: 038.P010

customer. The graphical user interface alerts the customer that the recordings are available by a cue such as 'YOU'VE GOT FLICKS.' See Hunter, paragraph 0139. Nowhere in Hunter does it teach permitting the analysis of the metadata to determine when to make the movie available for viewing," as recited in Assignee's claim 37. For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 37 is improper and respectfully requests that the Board reverse the Examiner's claim rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to those claims that depend from claim 37, as well.

J. WITH REGARD TO CLAIM 41 (AND ITS DEPENDENT CLAIMS OTHER THAN 78), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "A PROCESSOR FOR EXECUTING SOFTWARE, PROCESSING DATA RECEIVED THROUGH THE ANTENNA AND TUNER, AND FOR PROCESSING USER INPUT COMMANDS TO PERMIT ACCESS TO THE STORED MOVIE DATA UNDER PREDETERMINED CONTROL CONDITIONS TO PERMIT ACCESS TO THE STORED MOVIE DATA UNDER PREDETERMINED CONTROL CONDITIONS DERIVED FROM THE METADATA."

With regard to claim 41, Hunter does not teach, *inherently* or otherwise, "a processor for executing software, processing data received through the antenna and tuner, and for processing user input commands to permit access to the stored movie data under predetermined control conditions derived from the metadata," as recited by Assignee's claim 41. The Examiner asserts that "code keys for decryption of encoded movies, ID header information for determining the movie is available or interested to the user decrypting the movies once the user is authorized to access the movie" teaches the recited language from claim 41. Assignee respectfully disagrees with the Examiner's asserted position. Based on the Examiner's own assertion regarding Hunter, it is clear that Hunter does not teach the "a

processor for executing software, processing data received through the antenna and tuner, and for processing user input commands to permit access to the stored movie data under predetermined control conditions derived from the metadata" because there is no discussion in Hunter of deriving control conditions from the metadata. Hunter only discloses a system wherein "[t]he user station downloads movies to the intermediate storage in storage module 230 just as if the recording had been preselected by the customer. The graphical user interface alerts the customer that the recordings are available by a cue such as 'YOU'VE GOT FLICKS'." See Hunter, paragraph 0139. Hunter makes no mention of "control conditions derived from the metadata," as recited by Assignee's claim 41. For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 41 is improper and respectfully requests that the Board reverse the Examiner's claim rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to the claims that depend from claim 41 (other than 78), as well.

K. WITH REGARD TO CLAIM 52 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "ANALYZING OF THE METADATA TO DETERMINE WHEN TO MAKE THE MOVIES AVAILABLE FOR VIEWING."

With regard to claim 52, Hunter does not teach, *inherently* or otherwise "analyzing of the metadata to determine when to make the movie available for viewing," as recited in Assignee's claim 52. Hunter only discloses a system wherein "[t]he user station downloads movies to the intermediate storage in storage module 230 just as if the recording had been preselected by the customer. The graphical user interface alerts the customer that the recordings are available by a cue such as 'YOU'VE GOT FLICKS'." See Hunter, paragraph 0139. Hunter makes no mention of "analyzing metadata," as recited by Assignee's claim 52. For at least these reasons, Assignee respectfully asserts that the

Attorney Docket: 038.P010

Examiner's rejection of claim 52 is improper and respectfully requests that the Board reverse the Examiner's claim rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to the claims that depend from claim 52, as well.

L. WITH REGARD TO CLAIM 59, HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "STORING FOR A PREDETERMINED TIME ON THE SET-TOP BOX THE MOVIE DATA BROADCAST FROM THE CONTENT PROVIDER ONTO THE SET-TOP BOX, THE PREDETERMINED TIME BEING ESTABLISHED BY THE CONTENT PROVIDER."

With regard to claim 59, Hunter does not teach, *inherently* or otherwise, "storing for a predetermined time on the set-top box the movie data broadcast from the content provider onto the set-top box, the predetermined time being established by the content provider," as recited by Assignee's claim 59. Assignee respectfully asserts that the Examiner has misconstrued or misunderstood Hunter. Specifically, in Hunter the content provider does not control the downloading of movies and, therefore, cannot *necessarily* determine a time for removal of movie data. For example, Hunter states that its system uses a "first in, first out" write-over protocol that "would permit each automatically downloaded movie to remain in storage module 230 and available for on-demand viewing for approximately two weeks, with the exact time depending on how many customer-selected movies are downloaded during that period." See Hunter, paragraph 0139 (emphasis supplied). As discussed above, the Examiner has failed to clearly show "that the missing descriptive matter is *necessarily* present in [Hunter], and that it would be so recognized by persons of ordinary skill," because Hunter does not teach "storing for a predetermined time on the set top box the movie data broadcast from the content provider onto the set-top box, the predetermined time being established by the content provider," as recited by Assignee's

claim 59. For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 59 is improper and respectfully requests that the Board reverse the Examiner's claim rejection.

M. WITH REGARD TO CLAIM 72 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "PERMITTING ANALYSIS OF THE METADATA TO DETERMINE WHEN TO MAKE THE VIDEO AVAILABLE FOR VIEWING."

With regard to claim 72, Hunter does not teach, *inherently* or otherwise, "permitting analysis of the metadata to determine when to make the video available for viewing," as recited by Assignee's claim 72. Hunter only discloses a system wherein "[t]he user station downloads movies to the intermediate storage in storage module 230 just as if the recording had been preselected by the customer. The graphical user interface alerts the customer that the recordings are available by a cue such as 'YOU'VE GOT FLICKS'." See Hunter, paragraph 0139. Hunter makes no mention of "permitting analysis of the metadata to determine when to make the video available for viewing," as recited by Assignee's claim 72. For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 72 is improper and respectfully requests that the Board reverse the Examiner's claim rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to the claims that depend from claim 72, as well.

N. WITH REGARD TO CLAIM 83 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE "THE METADATA BEING UTILIZED BY THE SET TOP BOX TO DELETE THE CONTENT."

With regard to claim 83, Hunter does not teach "the metadata being utilized by the set top box to delete the content," as recited by claim 83. Assignee respectfully asserts that the Examiner has

Attorney Docket: 038.P010

misconstrued or misunderstood Hunter. Specifically, in Hunter, the content provider does not control the downloading of movies and, therefore, cannot *necessarily* determine a time for removal of movie data. For example, Hunter states that its system uses a “first in, first out” write-over protocol that “would permit each automatically downloaded movie to remain in storage module 230 and available for on-demand viewing for approximately two weeks, with the exact time depending on how many customer-selected movies are downloaded during that period.” See Hunter, paragraph 0139 (emphasis supplied). As discussed above, the Examiner has failed to clearly show “that the missing descriptive matter is *necessarily* present in [Hunter], and that it *would be so recognized* by persons of ordinary skill.” For at least these reasons, Assignee respectfully asserts that the Examiner’s rejection of claim 83 is improper and respectfully requests that the Board reverse the Examiner’s claim rejection. Likewise, Assignee requests that the Board reverse the Examiner’s claim rejections with respect to the claims that depend from claim 83, as well.

O. WITH REGARD TO CLAIM 88 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE “TRANSMITTING METADATA INCLUDING THE INSTRUCTION TO DELETE SPECIFIC CONTENT TO THE SET TOP BOX, THE SET TOP BOX HAVING LOGIC THEREIN THAT INTERPRETS THE INSTRUCTION AND DELETING THE PREVIOUSLY STORED CONTENT REFERENCED IN THE INSTRUCTION.”

With regard to claim 88, Hunter fails to teach or suggest “transmitting metadata including the instruction to delete specific content to the set top box, the set top box having logic therein that interprets the instruction and deleting the previously stored content referenced in the instruction,” as recited in Assignee’s claim 88. Assignee respectfully asserts that the Examiner has misconstrued or misunderstood Hunter. Specifically, in Hunter, the content provider does not control the downloading of

movies and, therefore, cannot *necessarily* determine a time for removal of movie data. For example, Hunter states that its system uses a “first in, first out” write-over protocol that “would permit each automatically downloaded movie to remain in storage module 230 and available for on-demand viewing for approximately two weeks, with the exact time depending on how many customer-selected movies are downloaded during that period.” See Hunter, paragraph 0139 (emphasis supplied). Again, the Examiner concedes this point and argues that the cited portions of Hunter *inherently* disclose Assignee’s claimed subject matter. As discussed above, Assignee respectfully asserts that the Examiner has failed to clearly show “that the missing descriptive matter is *necessarily* present in [Hunter], and that it *would be so recognized* by persons of ordinary skill.” For at least these reasons, Assignee respectfully asserts that the Examiner’s rejection of claim 88 is improper and respectfully requests that the Board reverse the Examiner’s claim rejection. Likewise, Assignee requests that the Board reverse the Examiner’s claim rejections with respect to the claims that depend from claim 88, as well.

P. WITH REGARD TO CLAIM 91 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE “TRANSMITTING METADATA TO A SET TOP BOX, THE METADATA BEING ASSOCIATED WITH CONENT PREVIOUSLY STORED ON THE SET TOP BOX, THE METADATA BEING UTILIZED BY THE SET TOP BOX TO MAKE THE CONTENT UNAVAILABLE TO A USER.”

With regard to claim 91, Hunter does not teach, inherently or otherwise, “transmitting metadata to a set top box, the metadata being associated with content previously stored on the set top box, the metadata being utilized by the set top box to make the content unavailable to a user,” as recited by Assignee’s claim 91 (emphasis supplied). Assignee respectfully asserts that the Examiner has misconstrued or misunderstood Hunter. Specifically, in Hunter, the content provider does not control the downloading of movies and, therefore, cannot *necessarily* determine a time for removal of movie

Attorney Docket: 038.P010

data. For example, Hunter states that its system uses a ““first in, first out’ write-over protocol [that] would permit each automatically downloaded movie to remain in storage module 230 and available for on-demand viewing for approximately two weeks, with the exact time depending on how many customer-selected movies are downloaded during that period.” See Hunter, paragraph 0139 (emphasis supplied). Again, the Examiner concedes this point and argues that the cited portions of Hunter *inherently* disclose Assignee’s claimed subject matter. As discussed above, Assignee respectfully asserts that the Examiner has failed to clearly show “that the missing descriptive matter is *necessarily* present in [Hunter], and that it *would be so recognized* by persons of ordinary skill.” For at least these reasons, Assignee respectfully asserts that the Examiner’s rejection of claim 91 is improper and respectfully requests that the Board reverse the Examiner’s claim rejection. Likewise, Assignee requests that the Board reverse the Examiner’s claim rejections with respect to the claims that depend from claim 91, as well.

Q. WITH REGARD TO CLAIM 95 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE “ANALYZING EACH OF THE SETS OF METADATA TO DETERINE IF THE SET OF METADATA MEETS PRE-DETERMINE CRITERIA ESTABLISHED BY THE CONTENT PROVIDER FOR DISPLAYING THE MOVIE ASSOCIATED WITH THE SET OF METADATA IN A LISTING OF AVAILABLE MOVIES FOR VIEWING IN A USER INTERFACE ASSOCIATED WITH THE SET TOP BOX.”

With regard to claim 95, Hunter does not teach, *inherently* or otherwise, “analyzing each of the sets of metadata to determine if the set of metadata meets pre-determined criteria established by the content provider for displaying the movie associated with the set of metadata in a listing of available movies for viewing in a user interface associated with the set top box,” as recited by Assignee’s claim

Attorney Docket: 038.P010

95. Hunter only discloses a system wherein “[t]he user station downloads movies to the intermediate storage in storage module 230 just as if the recording had been preselected by the customer. The graphical user interface alerts the customer that the recordings are available by a cue such as ‘YOU’VE GOT FLICKS.’” See Hunter, paragraph 0139. Hunter makes no mention of “analyzing each of the sets of metadata to determine if the set of metadata meets pre-determined criteria established by the content provider for displaying the movie associated with the set of metadata in a listing of available movies for viewing in a user interface associated with the set top box,” as recited by Assignee’s claim 95. For at least these reasons, Assignee respectfully asserts that the Examiner’s rejection of claim 95 is improper and respectfully requests that the Board reverse the Examiner’s claim rejection. Likewise, Assignee requests that the Board reverse the Examiner’s claim rejections with respect to the claims that depend from claim 95, as well.

R. WITH REGARD TO CLAIM 98 (AND ITS DEPENDENT CLAIMS), HUNTER DOES NOT, EXPRESSLY OR INHERENTLY, DESCRIBE OR DISCLOSE “ESTABLISHING PRE-DETERMINED CRITERIA THAT DETERMINE WHETHER CONTENT SHOULD BE DISPLAYED;...AND TRANSMITTING THE METADATA TO THE SET TOP BOX SO THAT THE METADATA IS ANALYZED TO DETERMINE IF THE PRE-DETERMINED CRITERIA IS MET, THE CONTENT BEING MADE AVAILABLE FOR VIEWING IF THE PRE-DETERMINED CRITERIA IS MET.”

With regard to claim 98, Hunter does not teach, *inherently* or otherwise, “establishing pre-determined criteria that determine whether content should be displayed; ... and transmitting the metadata to the set top box so that the metadata is analyzed to determine if the pre-determined criteria is met, the content being made available for viewing if the pre-determined criteria is met,” as recited by Assignee’s claim 98. Hunter only discloses a system wherein “[t]he user station downloads movies to the

intermediate storage in storage module 230 just as if the recording had been preselected by the customer. The graphical user interface alerts the customer that the recordings are available by a cue such as "YOU'VE GOT FLICKS." See Hunter, paragraph 0139. Hunter makes no mention of "analyzing each of the sets of metadata to determine if the set of metadata meets pre-determined criteria established by the content provider for displaying the movie associated with the set of metadata in a listing of available movies for viewing in a user interface associated with the set top box," as recited by Assignee's claim 98. For at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 98 is improper and respectfully requests that the Board reverse the Examiner's claim rejection. Likewise, Assignee requests that the Board reverse the Examiner's claim rejections with respect to the claims that depend from claim 98, as well.

2. THE APPLIED DOCUMENTS, ALONE OR IN COMBINATION, DO NOT TEACH EACH AND EVERY ELEMENT OF REJECTED CLAIMS 11, 43-48, AND 78. ADDITIONALLY, THERE IS NO EVIDENCE OF A SUGGESTION OR MOTIVATION TO COMBINE THE APPLIED DOCUMENTS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the applied documents themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the applied documents or to combine teachings from those documents. Second, there must be a reasonable expectation of success. Finally, the applied documents (or applied documents when combined) must teach or suggest all the claim limitations of the rejected claims. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the applied documents, and not based on Assignee's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Attorney Docket: 038.P010

As discussed above, Hunter does not teach, *inherently* or otherwise, all of the elements of the respective base claims of claims 11, 43-48, and 78. For example, Hunter does not teach “effecting removal of the movie data representing one or more movies stored on the set-top box at a time determined by the content provider,” as recited in Assignee’s claim 10. Claim 11 depends from claim 10. Likewise, Hunter makes no mention of “control conditions derived from the metadata,” as recited by Assignee’s claim 43. Claims 44-48 depend from claim 43. Finally, claim 78 depends from claim 41, discussed above. The documents applied by the Examiner do not cure these deficiencies. For at least these reasons, Assignee respectfully asserts that the Examiner’s rejection of these claims is improper and respectfully requests that the Board reverse the Examiner’s claim rejections.

In addition, the Examiner has cited no teaching or motivation to combine the teachings of the applied documents. To establish a *prima facie* case for obviousness, the Examiner must establish some suggestion or motivation, either in the cited patents themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the cited documents or to combine their teachings. The Examiner has not cited any portion of the applied documents that would suggest combining their respective teachings. Likewise, the Examiner has not established a suggestion or motivation to combine the applied patents from knowledge generally available to one of ordinary skill. The Examiner merely asserts that it would have been obvious to combine the teachings of the cited documents. In light of the Examiner’s failure to establish a suggestion or motivation to combine the applied documents, it is respectfully asserted that the Examiner has failed to establish a *prima facie* case of unpatentability with respect to the rejected claims. Again, Assignee respectfully requests that these rejections be reversed by the Board.

Attorney Docket: 038.P010

CONCLUSION

For at least the reasons above, Assignee respectfully submits that claims 4-16, 18-35, 37, 41-48, 52-59, 61-63, and 72-100 all patentably distinguish over the documents applied by the Examiner. Assignee, therefore, respectfully requests that the Board reverse the Examiner's rejections of these claims and remand this case to the Examiner instructing him to permit the pending claims to proceed to issuance.

Respectfully submitted,

Dated: 1-22-07



Steven J Munson
Reg. No. 47,812

Berkeley Law and Technology Group, LLC
1700 NW 167th Place, Suite 240
Beaverton, OR 97006

CLAIM APPENDIX**Claims 1 – 3 (cancelled)**

Claim 4 (original): A method of broadcasting a movie to a set-top box, the method comprising:
a content provider broadcasting movie data to a set-top box, the content of the movie data being selected by the content provider;
permitting automatic storage of the movie data broadcast from the content provider onto the set-top box;
permitting assembling the movie data in the set top box to form at least one full movie and associated metadata;
permitting analysis of the metadata to determine when to make the movie available for viewing;
and
permitting viewing of the movie in response to a user's selection of the movie.

Claim 5 (original): The method of claim 4 wherein permitting viewing occurs upon agreement to charge the user a fee for viewing the selected movie.

Claim 6 (original): The method of claim 4 wherein associated metadata comprises information such as time stamps which determine begin and end dates for permitted movie viewing.

Claim 7 (original): The method of claim 4 wherein the movie selected by the user is available for viewing for a limited period of time.

Claim 8 (original): The method of claim 4 wherein the movie selected is available for viewing for a limited number of times.

Claim 9 (original): The method of claim 4, and further comprising the step of repeatedly re-broadcasting movie data thereby to ensure that the entire movie is received by the set-top box.

Claim 10 (original): A method of broadcasting movies to a set-top box, the method comprising:
a content provider broadcasting movie data to a set-top box, the content of the movie data being selected by the content provider and not by the user;

Attorney Docket: 038.P010

permitting automatic storage on the set-top box of the movie data broadcast from the content provider;

permitting assembly of the movie data to form a plurality of full movies;

making selected movies available for viewing by the user at a time pre-determined by the content provider, the selected movie having previously been stored on the set-top box; and

effecting removal of the movie data representing one or more movies stored on the set-top box at a time determined by the content provider.

Claim 11 (original): The method of claim 10 wherein the movie data is transmitted and stored to the set top box at a time being at least one day, and preferably about a week, before making the movie available for viewing.

Claim 12 (original): The method of claim 10 wherein the movie data comprises audio and video to form a movie and associated metadata, wherein the metadata indicates the time predetermined by the content provider to make the movie available for viewing by the user.

Claim 13 (previously presented): The method of claim 12 wherein the movie is a new release and the time predetermined by the content provider to permit viewing by a user is an official release date for the new release.

Claim 14 (original): The method of claim 10 wherein movie data is broadcast to the set-top box using standard file transfer protocols.

Claim 15 (original): The method of claim 10 further comprising the step of repeatedly re-broadcasting movie data thereby to ensure that the entire movie is received by the set-top box.

Claim 16 (original): The method of claim 10 wherein a movie is made available for viewing by the user upon payment of a fee.

Claim 17 (cancelled)

Claim 18 (Previously presented): A method of broadcasting movies to a set-top box for storage and subsequent viewing, the method comprising:

selectively broadcasting data wirelessly from a content provider to a set-top box;
remotely controlling when to make data available for viewing by the user; and
remotely controlling when to remove data from the set-top box.

Claim 19 (original): The method of claim 18 including permitting the user to select when to view selected data during an available access time, the user selectively viewing the data on one or more television sets, and the set top box being a unit separate from the one or more television set.

Claim 20 (previously presented): The method of claim 18 wherein payment for viewing of the data is made by the user through a separate telephone line.

Claim 21 (original): The method of claim 18 wherein selectively broadcasting data permits the content provider to determine the data to be broadcast wirelessly to the set-top box.

Claim 22 (original): The method of claim 18 wherein data is broadcast by encoding data onto standard broadcast television signals.

Claim 23 (previously presented): A method of content management for a remote hardware device, the method comprising the steps of:

collecting content to be transmitted to a remote hardware device;
generating metadata specifying various properties of the content;
associating the metadata with the content;
transmitting the content and its associated metadata to the remote hardware device;
permitting automatic storage of the data received at the remote hardware device;
providing software for operating on the remote hardware device to process the metadata and manage the content according to its associated metadata.

Claim 24 (original): The method of claim 23 wherein the metadata comprises information indicating when to make content available to the viewer and when to remove content from the hardware device.

Claim 25 (previously presented): The method of claim 18 further comprising repeatedly re-broadcasting movie data thereby to ensure that the entire movie is received by the set-top box.

Claim 26 (original): A method of providing movies available for purchase or rental directly to remote viewers through broadcast communication, the method comprising,

providing a viewer with a set top box, the set top box having a hard drive for storing a plurality of movies;

broadcasting movie data to the set top box and allowing movie data to accumulate on the hard drive; and

providing software resident on the set top box, the software being programmed to:

automatically store the movie data broadcast to the set top box;

assemble the movie data into a plurality of viewable movies and associated metadata;

analyze the metadata to determine when a movie should be made available; and

allow the user to select the available movie when available.

Claim 27 (previously presented): A method as claimed in claim 26 wherein the movies are available for a predetermined limited time and thereafter are essentially removed by the broadcaster.

Claim 28 (original): A method as claimed in claim 26 wherein the movies are encrypted thereby to limit the availability in at least one of the following respects, being copied multiple times, being viewed more than once, or being viewed or copied other than when predetermined criteria are met.

Claim 29 (original): A method as claimed in claim 26 wherein the movie is broadcast by encoding data representative of the movie onto standard broadcast television signals.

Claim 30 (original): A method of creating a digital home movie library, the method comprising the steps of:

having a content provider broadcast movie data to a plurality of set-top boxes, the content of the movie data being selected by the content provider and being uncontrolled by the user;

automatically storing on the set-top box the movie data broadcast from the content provider;

assembling the movie data to form a plurality of full movies; and

making one or more of the movies available to the user at a time predetermined by the content provider.

Claim 31 (previously presented): A method as claimed in claim 30 wherein the movies are available for a predetermined limited time and thereafter are essentially removed by the broadcaster.

Claim 32 (original): A method as claimed in claim 30 wherein the movies are encrypted thereby to limit the availability in at least one of the following respects, being copied multiple times, being viewed more than once, or being viewed or copied other than when predetermined criteria are met.

Claim 33 (original): A method as claimed in claim 30 wherein the movie is broadcast by encoding data representative of the movie onto standard broadcast television signals.

Claim 34 (original): The method of claim 26 wherein payment for the data is made through a separate telephone line.

Claim 35 (original): The method of claim 30 wherein selectively broadcasting comprises the content provider determining what data is broadcast wirelessly to the set-top box.

Claim 36 (cancelled)

Claim 37 (original): A method of distributing movies directly to viewers at home comprising: providing a viewer with a set top box, the set top box having a hard drive for storing a plurality of movies and software for permitting access to the movies;

broadcasting at least one movie and associated data to the set top box wirelessly prior to an official release date for the movie, the associated data regulating the release date of the movie on the set top box; and

automatically storing the movies and its associated data to the set top box hard drive; analyzing the associated data to determine when the movies should be made available for viewing; and

permitting viewing of the movie on its release date.

Claims 38 – 40 (cancelled)

Claim 41 (previously presented): A digital home movie library system for providing access to the movies comprises:

an antenna and a tuner for receiving broadcast signals;

a hard disk drive for storing movie data and metadata transmitted by the broadcast signals and received through the antenna; and

a processor for executing software, processing data received through the antenna and tuner, and for processing user input commands to permit access to the stored movie data under predetermined control conditions derived from the metadata.

Claim 42 (original): A digital home movie library as claimed in claim 41 including a modem to permit electronic billing of the user for access of the library.

Claim 43 (original): A system for providing access to movies comprising:

an antenna and receiver for receiving broadcast signals;

a processor for executing software, processing data received through the antenna and tuner, and for processing user input commands to permit access to the stored movie data under predetermined control conditions;

a hard disk drive for storing movie data transmitted by the broadcast signals and received through the antenna; and

a smart card secured to a circuit board of the receiver, the smart card facilitating a dedicated use of the receiver with a designated user.

Claim 44 (original): A system as claimed in claim 43 wherein including a modem to permit electronic billing of the user for access to the movies in the hard drive storage.

Claim 45 (original): A system of claim 43 wherein the receiver and antenna form part of a set top box for operation with a monitor.

Attorney Docket: 038.P010

Claim 46 (original): A system of claim 43 wherein the receiver and antenna form part of a set top box, and including an integral fastening of an active component of a smart card to a circuit board of the set top box thereby to impede removal, and enhance the security of the set top box.

Claim 47 (original): The system of claim 43 including a secondary external smart card slot for use with another smart card in case the system becomes compromised.

Claim 48 (original): The system of claim 46 wherein the smart card is fastened to a main board of the set top box with epoxy.

Claim 49 – 51 (cancelled)

Claim 52 (original): A method of a remote user receiving a movie broadcast to a set-top box, the method comprising:

receiving movie data broadcast by a content provider to a set-top box of a user, the content of the movie data being selected by the content provider;

storing of the movie data broadcast from the content provider onto the set-top box;
assembling the movie data in the set top box to form at least one full movie and associated metadata;

analyzing of the metadata to determine when to make the movie available for viewing; and
viewing of the movie in response to the remote user's selection of the movie.

Claim 53 (previously presented): The method of claim 52 wherein viewing occurs upon agreement to charge the user a fee for viewing the selected movie.

Claim 54 (previously presented): The method of claim 52 wherein the movie selected by the user is available for viewing for a limited period of time.

Claim 55 (previously presented): The method of claim 52 wherein the movie selected is available for viewing for a limited number of times.

Attorney Docket: 038.P010

Claim 56 (previously presented): A method of a remote user receiving a broadcast movie to a set-top box, the method comprising:

receiving from a content provider movie data broadcast to a set-top box, the content of the movie data being selected by the content provider and not by the remote user;

automatically storing on the set-top box the movie data broadcast from the content provider;

assembling of the movie data to form a plurality of full movies;

selecting movies for viewing by the user at a time pre-determined by the content provider, the selected movie having previously been stored on the set top box; and

removing the movie data representing one or more movies stored on the set top box at a time determined by the content provider.

Claim 57 (previously presented): The method of claim 56 further comprising the step of repeatedly receiving rebroadcast movie data thereby to ensure that the entire movie is stored by the set-top box.

Claim 58 (previously presented): The method of claim 56 wherein a movie is made available for viewing by the user upon payment of a fee.

Claim 59 (original): A method of receiving a broadcast a movie on a set-top box of a remote user, the method comprising:

receiving a broadcast movie from a content provider broadcasting movie data to a set-top box, the content of the movie data being selected by the content provider; and

storing for a predetermined time on the set top box the movie data broadcast from the content provider onto the set-top box, the predetermined time being established by the content provider.

Claim 60 (withdrawn): A method of permitting a remote user to view a showcasing of the contents of a digital movie library, the method comprising the steps of:

providing a user interface comprising a scrolling marquee and a window, whereby the scrolling marquee features a plurality of images, each image representing a movie, and the window contains a video loop, comprising trailers for movies; and

permitting the user to view the interface.

Claim 61 (original): A method of claim 59 wherein the remote user receives and processes a broadcast of a movie to a set-top box, the method further comprising:

receiving through an antenna a content provider broadcasting via wireless telecommunication over a television frequency spectrum of at least one movie, the movie being selected by the content provider and not by the remote user; and

storing of the movie broadcast from the content provider in a set-top box without interaction by the user.

Claim 62 (withdrawn): The method of claim 60 wherein viewing occurs upon agreement to charge the user a fee for viewing the selected movie.

Claim 63 (original): The method of claim 61 wherein the movie selected by the user is available for viewing for a limited period of time.

Claim 64 (withdrawn): A method of broadcasting designated audio content to a hardware device, the method comprising:

a content provider broadcasting via wireless telecommunication over a designated frequency spectrum at least one audio to a hardware device, the designated audio content being selected by the content provider and not by the user; and

permitting storage of the designated audio content broadcast from the content provider in the hardware device without interaction by the user.

Claim 65 (withdrawn): The method of claim 63 further comprising the step of indicating that the designated audio content is available once the entire designated audio content has been received on the hardware device; and

permitting access to said designated audio content by a user.

Claim 66 (withdrawn): The method of claim 63 further comprising the step of re-broadcasting designated audio content data previously broadcast to ensure that the entire designated audio content is received by the hardware device.

Attorney Docket: 038.P010

Claim 67 (withdrawn): A method of broadcasting a designated audio content to a set-top box, the method comprising:

 a content provider broadcasting designated audio content data to a hardware device, the content of the designated audio content data being selected by the content provider;

 permitting automatic storage of the designated audio content data broadcast from the content provider onto the hardware device;

 permitting assembling the designated audio content data in the hardware device to form at least one full designated audio content and associated metadata;

 permitting analysis of the metadata to determine when to make the designated audio content available; and

 permitting access to the designated audio content in response to a user's selection of the designated audio content.

Claim 68 (withdrawn): The method of claim 66 wherein permitting access occurs upon agreement to charge the user a fee for viewing the selected designated audio content.

Claim 69 – 71 (cancelled)

Claim 72 (original): A method of broadcasting a video to a set-top box, the method comprising:

 a content provider broadcasting video data to a set-top box, the content of the video data being selected by the content provider;

 permitting automatic storage of the video data broadcast from the content provider onto the set-top box;

 permitting assembling the video data in the set top box to form at least one full video and associated metadata;

 permitting analysis of the metadata to determine when to make the video available for viewing; and

 permitting viewing of the video in response to a user's selection of the video.

Claim 73 (previously presented): The method of claim 72 wherein permitting viewing occurs upon agreement to charge the user a fee for viewing the selected video.

Attorney Docket: 038.P010

Claim 74 (previously presented): The method of claim 72 wherein the video selected by the user is available for viewing for a limited period of time.

Claim 75 (previously presented): The method of claim 72 comprising the step of repeatedly re-broadcasting video data thereby to ensure that the entire video is received by the set-top box.

Claim 76 (original): A system as claimed in claim 41 wherein the set-top box includes a modem, and wherein the set-top includes software to periodical permit contact with the content provider through the modem.

Claim 77 (previously presented): A system as claimed in claim 76 information passed between the content provider and the set-top via the modem includes at least one of a user's viewing/rental history, access information used for billing purposes, set-top performance logs to monitor the performance of the system or keys used to decrypt videos.

Claim 78 (previously presented): A system as claimed in 76 wherein the processor simultaneously plays a video and reacts to signals from a remote control, and modem activity.

Claim 79 (previously presented): A system as claimed in claim 76 wherein the hard drive is physically mated with the set-top box structure for security purposes thereby rendering it useless for its intended storage purpose if removed for intended use apart from the set top box.

Claim 80 (original): A method of broadcasting movies to a set-top box for storage and subsequent viewing as claimed in claim 18 wherein videos stored on the set top box are encrypted, and upon selection of a video to view and satisfaction of business rules, the set top box permits the video to be decrypted and played.

Claim 81 (original): A method of broadcasting movies to a set-top box for storage and subsequent viewing as claimed in claim 18 wherein the set-top box is not necessarily connected to the content provider after the video is stored, and prior to allowing a video to be viewed, the video is being capable of independent decryption by electronic keys on the set-top box along with the current account status.

Claim 82 (previously presented): A method of broadcasting movies to a set-top box for storage and subsequent viewing as claimed in claim 18 including logging a decryption of a movie and using this log to determine a user's bill.

Claim 83 (previously presented): A method of remotely deleting content on a set top box, comprising:

transmitting metadata from a content provider to a set top box, the metadata being associated with content previously stored on the set top box, the metadata being utilized by the set top box to delete the content.

Claim 84 (previously presented): The method of claim 83 wherein the metadata comprises a date on which the set top box is authorized to initiate deletion of the content.

Claim 85 (previously presented): The method of claim 83 wherein the content previously stored on the set top box is transmitted remotely from the content provider.

Claim 86 (previously presented): The method of claim 83 wherein the content previously stored on the set top box is loaded without being transmitted remotely from the content provider.

Claim 87 (previously presented): The method of claim 83 wherein deletion of content is independent from making room for new content as a result of available disk space.

Claim 88 (previously presented): A method of remotely deleting content from a set top box, comprising:

composing an instruction to delete specific content previously stored on a set top box; and transmitting metadata including the instruction to delete specific content to the set top box, the set top box having logic therein that interprets the instruction and deleting the previously stored content referenced in the instruction.

Claim 89 (previously presented): The method of claim 88 wherein the content previously stored on the set top box is transmitted remotely from the content provider.

Claim 90 (previously presented): The method of claim 88 wherein the content previously stored on the set top box is loaded without being transmitted remotely from the content provider.

Claim 91 (previously presented): A method of remotely managing content on a set top box, comprising:

transmitting metadata to a set top box, the metadata being associated with content previously stored on the set top box, the metadata being utilized by the set top box to make the content unavailable to a user.

Claim 92 (previously presented): The method of claim 91 wherein the metadata comprises a date on which the set top box is authorized to initiate making the content unavailable.

Claim 93 (previously presented): The method of claim 91 wherein the content previously stored on the set top box is transmitted remotely from a content provider.

Claim 94 (previously presented): The method of claim 91 wherein the content previously stored on the set top box is loaded without being transmitted remotely from a content provider.

Claim 95 (previously presented): A method of displaying available movies stored on a set top box, comprising:

receiving a plurality of movies from a content provider;

receiving a plurality of sets of metadata, each of the sets of metadata being associated with one of the plurality of movies; and

analyzing each of the sets of metadata to determine if the set of metadata meets pre-determined criteria established by the content provider for displaying the movie associated with the set of metadata in a listing of available movies for viewing in a user interface associated with the set top box.

Claim 96 (previously presented): The method of claim 95 wherein the pre-determined criteria is a date on which the set top box is authorized to display the movie.

Claim 97 (previously presented): The method of claim 95 wherein the pre-determined criteria is a time at which the set top box is authorized to display the movie.

Claim 98 (previously presented): A method of displaying available movies stored on a set top box, comprising:

establishing pre-determined criteria that determine whether content should be displayed; composing metadata that includes the pre-determined criteria; transmitting content associated with the metadata to the set top box; and transmitting the metadata to the set top box so that the metadata is analyzed to determine if the pre-determined criteria is met, the content being made available for viewing if the pre-determined criteria is met.

Claim 99 (previously presented): The method of claim 98 wherein the pre-determined criteria is a date on which the set top box is authorized to display the movie.

Claim 100 (previously presented): The method of claim 98 wherein the pre-determined criteria is a time at which the set top box is authorized to display the movie.

To: Mail Stop Appeal Brief

From: Michelle Turner for Steven J. M

1-22-07 5:59pm p. 50 of 52

Attorney Docket: 038.P010

EVIDENCE APPENDIX

None.

To: Mail Stop Appeal Brief

From: Michelle Turner for Steven J. M

1-22-07 5:59pm p. 51 of 52

Attorney Docket: 038.P010

RELATED PROCEEDING APPENDIX

None.

Please find attached for filing in connection with application no. 10/646,192 entitled **DIGITAL HOME MOVIE LIBRARY**, the following documents:

- Appeal Brief (47 pages)
- Fee Transmittal (1 page)
- Petition for Extension of Time (1 page)

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- BLACK BORDERS**
- IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- FADED TEXT OR DRAWING**
- BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- SKEWED/SLANTED IMAGES**
- COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- GRAY SCALE DOCUMENTS**
- LINES OR MARKS ON ORIGINAL DOCUMENT**
- REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.